

REMARKS

Claims 1-27 are now currently pending in the application. New claim 25-27 are presented for consideration. No new matter is added. Reconsideration in view of the above amendments and following remarks is respectfully requested.

Specification Amendment

The specification has been amended to perfect the application number of a copending application entitled "Tracking Electronic Content", Application No. 09/199,150, filed November 24, 1998, and incorporated by reference in the present application as originally filed.

New Claims 25-27

Claims 25-27 are presented for the Examiner's consideration. Support for the new claims can be found at least on pages 8-11 and Figures 2A – 2D. The claims are directed to transmitting a notification when the electronic content (or requested data, as appropriate for claim 25) is accessed. The subject matter of claim 25-27 are patentably distinct from the cited prior art and are in condition for allowance.

35 U.S.C. §103(a) Rejection

The Examiner rejected claims 1-24 under §35 U.S.C. §103(a) as unpatentable over Powell (U.S. Patent No. 6,067, 526) (Powell) in view of Gupta *et al.* (U.S. Patent No. 6,484,156) (Gupta). Applicant respectfully traverses this rejection.

In response, Applicant has amended independent claims 1, 20, 21, 22, and 24. Support for the amendments can be found at pages 8-11 and Figures 2A-2D of the present application.

In order to reject a claim under 35 U.S.C. §103(a), MPEP 2143 mandates that three basic criteria must be met.

First, there must be some suggestion or motivation, either in the reference themselves or in knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations.

Applicant submits that the references do not teach or suggest all of the claimed limitations as amended. Specifically, claim 1 has been amended to now include the features:

“transmitting notification information when the requested data is accessed.”

Applicant submits that the combination of Powell and Gupta does not teach or suggest transmitting a notification when the requested data is accessed. Powell is directed to a system for dispensing and redeeming coupons where a user requests a coupon via email by selecting hypertext in a browser page which sends the user email address to a coupon server. Upon receiving the email, the coupon server sends an email to the user.

Gupta is directed to an annotation server using hierarchical annotation storage structure to maintain a correspondence between the annotations and a hierarchically maintained higher group identifier. Nowhere does Powell and Gupta teach or suggest separately or in combination “transmitting notification information when the requested data is accessed.” Applicant respectfully requests withdrawal of the withdrawal of the 35 U.S.C. §103(a) rejection.

Similarly, claims 21 and 24 have been amended to now include the features:

“transmitting notification information when the electronic content is accessed.”

Similar to the argument with respect to claim 1 above, Applicant submits that Powell and Gupta separately or in combination do not teach or suggest transmitting a notification when the electronic content is accessed or those features of claims 20 and 22. Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection now as being proper since the combination of Powell and Gupta do not show all of the features of the claimed invention and a *prima facie* case of obviousness cannot be made.

Similarly to claims 21 and 24, claim 20 has been amended to further include the additional features of:

“transmitting notification information...at the first computer.” Claim 22, recites:

“transmit notification information when the selected electronic content
is accessed.”

Applicant submits that neither the Powell or Gupta references alone or in combination do not teach or suggest all of the claimed features in independent claims 1, 20-22, and 24. Since claims 2-19 are depending from independent claim 1, Applicant submits that claims 2-19 are also directed to patentable subject matter and are therefore allowable. Claim 23 is dependent from independent claim 22 and therefore also drawn to patentable subject matter. Applicant submits that all the 35 U.S.C. §103(a) rejections now be withdrawn.

Conclusion

In view of the foregoing remarks, Applicant submits that the references do not teach all the features of the claimed invention. Applicant submits that all of the claims are patentably distinct from the prior art of record and are in condition for allowance and that the application should now be passed to issuance.

A Request for Continued Examination is also being filed herewith. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written petition for extension of time if needed. Please charge any deficiencies and credit any overpayment of fees to Attorney's Deposit Account No. 23-1951.

Respectfully submitted,



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